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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/079,449	02/19/2002	Gary W. Ferguson	FET 345	9169

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EXAMINER
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DAVIS, DAVID DONALD

ART UNIT	PAPER NUMBER
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2652

DATE MAILED: 03/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/079,449	<b>Applicant(s)</b> FERGUSON, GARY W.	
	<b>Examiner</b> David D. Davis	<b>Art Unit</b> 2652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 28 December 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,7-22,30 and 31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,7-22,30 and 31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 7-22, 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaneda et al (US 6,404,707) in view of Nakano (JP 08-96410). Kaneda et al shows in figure 11A a disk data storage media including a disk 10 having first and second disk surfaces and an optical disk edge surface with at least one of the first and second disk surfaces being an optical disk surface formed to store a first set of data, as described in column 9, lines 36-44. The edge surface of Kaneda et al is shown to have a substantially smooth surface with a printed layer including second set of data 990, wherein the first set of data can be used independently of the second set of data. The disk edge surface is readable and writable. See column 10, lines 13-19. Kaneda et al shows in figure 11A that the first and second disk surfaces have a maximum diameter.

Kaneda et al, however, is silent as to the substantially smooth surface being an underlying layer. Kaneda et al is also silent as to the disk edge surface being enlarged, within the confines of the maximum diameter and the enlarged disk edge surfaces being formed by increasing the thickness of the disk adjacent the disk edge.

Nakano shows in figures 1 and 4 layer 3 having a disk edge surface being enlarged, within the confines of the maximum diameter and the enlarged disk edge surfaces being formed by increasing the thickness of the disk adjacent the disk edge.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide the disc of Kaneda et al with a layer and a disk edge surface being enlarged and within the confines of the maximum diameter as taught by Nakano, thereby providing the disc of Kaneda et al with an underlayer. The rationale is as follows: one of ordinary skill in the art at the time the invention was made would have been motivated to provide a disc having a substantially smooth surface with a layer including a second set data thereby providing the disc with an underlayer, "to prevent an optical disk from corroding at the outer circumference edge". See the Abstract of Nakano.

### *Response to Arguments*

3. Applicant's arguments filed December 28, 2005 have been fully considered but they are not persuasive. On pages 2 and 3, applicant has a lengthy discussion regarding the term "edge" and whether or not the edge of Nakano is the same edge as the claimed edge of the instant application. It is clear that the end face of Nakano is the same as the claimed edge surface.

Applicant continues in the first paragraph on page 4 with the following assertion:

Nakano teaches away from the disclosure of the present invention. A person of skill in the art at the time of Applicant's invention, if looking to Nakano for guidance, would have learned not to apply a protective coating to the end face of the disk. Nakano solved a completely different problem.

Applicant's characterization of Nakano is not correct. If Nakano was not concerned about the end face and if Nakano was concerned about a completely different problem, why then in the ultimate line of section 35 would Nakano state the following:

The above-mentioned protective coat 3 is formed so that it may have desired thickness and this whole periphery end-face 1a may be covered to one to the whole periphery end-face 1a of the above-mentioned transparenance base 1.

Therefore, contrary to applicant's assertion Nakano is concerned about the same edge as the claimed edge, and Nakano as modified by Kaneda et al renders the claimed invention obvious, as shown *supra*.

On page 5, in the second full paragraph applicant contends that neither Kaneda nor Nakano "disclose an underlying layer". This statement is curious because on the first full paragraph on the same page 5 applicant states that "Kaneda must add something to his edge surface in order to store data on that surface . . . Somehow, he must provide bars on the surface to have a bar code." If Kaneda must add something to his edge surface "such as applying ink to the surface or building up the surface with bars or additionally material", how can the combination not have an underlying layer? Contary to applicant contention, the combination does provide an underlayer (i.e. the second set of optical data on the edge surface), as required by the claimed invention.

In the first full paragraph on page 6, Applicant maintains the following:

Kaneda discloses only a readable edge surface. He specifically describes a dedicated *read* circuit. He does not disclose, discuss, or even allude to being able to write on the edge surface.

If Kaneda does not disclose, discuss, or even allude to being able to write on the edge surface, as purported by applicant, how does the second set of optical data get on the edge. It has to be written, at the very least, initially.

***Conclusion***

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

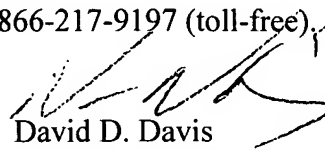
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David D. Davis whose telephone number is 571-272-7572. The examiner can normally be reached on Monday thru Friday between 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dwayne D. Bost can be reached on 571-272-7023. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2652

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David D. Davis  
Primary Examiner  
Art Unit 2652

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